

App. No. 10/081,801
Attorney Docket No. 3501.2.1 NP

Amendments to the Drawings

None

App. No. 10/081,801
Attorney Docket No. 3501.2.1 NP

Remarks

Applicant thanks the Examiner for the Written Office Action. In particular the Applicant would like to thank the Supervisory Examiner and the Examiner for the teleconference on September 26, 2007, wherein the issues regarding the 35 U.S.C. 112 Rejections of the current office action were discussed.

With regard to the substantive portion of the Written Office Action, the Examiner objected to amendments made in the specification. Specifically, the inclusion of CPU subsystem housing; elongated tab; securing system; and the application of lateral forces in the specification. Additionally, Claims 1, 8-9, 11-12, 15-20, 21-26, 27-29 were rejected under 35 U.S.C. 112, first paragraph. Further, Claims 1, 8-9, 11-12, 15-16, 18, 21-25, and 27-29 were rejected under 35 U.S.C. 102 (b) as being unpatentable over Ayd (U.S. 6025989). Claims 17 was rejected over Ayd in view of Savage; Claims 19-20, and 26 were rejected under 35 U.S.C. 103 as being unpatentable over Ayd in view of Mazingo.

In response to the current office action, the Applicant has amended the specification as shown, canceled Claims 1-29; and added Claims 30-50, as described in more detail below. The Applicant submits the above changes overcome the 35 U.S.C. 102, 103, and 112 objections. Further the Applicant submits that no new matter has been added, as support for the amendments and added claims may be found in the specification and claims as disclosed previously, and as described in more detail below.

Claims 32-50 include a first disk drive and a second disk drive. The Applicant submits this is not new matter as the original application includes description and support for additional disk drives (See paragraphs 23 and 47)

App. No. 10/081,801
Attorney Docket No. 3501.2.1 NP

Further, Claims 39 and 42-43 disclose a second disk drive being coupled to the underside of the main CPU unit. Applicant submits this is not new matter as the original application includes description and support for additional disk drives (See paragraphs 23 and 47)

Response to 112 rejections

Objections to Specification

In response to the Examiner's objections to the specification, the Applicant, while not conceding to the validity the Examiner's arguments, has deleted the CPU subsystem housing; the securing system; and the through the application of lateral force.

Accordingly, the Applicant believes the objections to the specification have been overcome.

Objections to Claims

In response to the Examiner's objection to Claims 1, 8-9, 11-12, 15-20, 21-26, 27-29, the Applicant has canceled Claims 1-29, and added new Claims 30-50. While the Applicant does not concede the validity of the Examiner arguments with regard to the current Office Action (dated 7/17/2007), the Applicant believes the added Claims overcome the Examiner's 112 claim objections.

Specifically, the new claims do not include: standard disk drive enclosure; selectably removable...application of lateral force; CPU not coupled to the disk... via base support member; CPU subsystem housing. While the Applicant still believes this does not constitute a valid 35 U.S.C. 112 rejection, the Applicant believes the new claims overcome the claim objections.

App. No. 10/081,801
Attorney Docket No. 3501.2.1 NP

The limitation of "not including an internal power supply" is not new matter

In response to the current office action and the Examiner teleconference of September 26, 2007, the Applicant has included the limitation of "wherein the at least one server does not include an internal power supply." The Applicant respectfully disagrees with the Examiner the absence of an internal power supply in the server constitutes new matter. First, nowhere in the application is there any disclosure (explicit or inherent) of an internal power supply in the server (as shown and described in the Application, see figures, paragraphs etc.). Specifically, looking at figure 2 and paragraphs 15 and 16, the components of the server are shown and described.

Additionally, the scope of application as filed inherently discloses the absence of an internal power supply in the server. This is clearly demonstrated by one of main patentable features of the invention as originally disclosed. First, the background of the invention (which is part of the original specification) teaches and discusses the problems of an internal power supply as shown in the prior art. Indeed, paragraph 8 explicitly says prior art "suffers from the need for a separate power supply and cooling fan contained within each rack unit."

The detailed description of the invention further supports the absence of an internal power supply. For example, paragraph 34 teaches and discloses components of the server are directed towards "requiring less power." Indeed, if an internal power supply had been part of the original disclosure it would contradict the scope as described in paragraphs 34 and 42, as this would have an internal power supply in addition to the single power supply 315.

App. No. 10/081,801
Attorney Docket No. 3501.2.1 NP

The Applicant respectfully disagrees that the Applicant's original specification is required to specifically say, "does not include an internal power supply." To avoid a new matter rejection the Applicant must show the matter is supported by the original application. See *Kolmes v. World Fibers Corp.* 107 F.3d 1534, 1539, 41 USPQ2d 1829, 1832 (Fed. Cir. 1997). Indeed, "the fundamental inquiry is whether the material added by the amendment was inherently contained in the original application." See *Litton Sys v. Whirlpool Corp.* 728 F.2d 1423, 1438, 221 USPQ 97 106 (Fed. Cir. 1984). Therefore, the Applicant's amendment regarding the absence of an internal power supply in the server need not be specifically said, nor even explicitly contained in the application. Rather, the absence of an internal power supply needs to be inherent in the original application. Indeed, the Applicant must show the matter is supported by the original application. See *Kolmes*. The Applicant respectfully submits the above paragraphs inherently disclose and teach the scope of the original application as including the absence of the internal power supply, and therefore should not be new matter.

"Consisting essentially of" objection is not proper

In response to the Examiner's objection of "consisting essentially of," the Applicant respectfully disagrees with need to modify this language. As disclosed in the previous office action response, MPEP § 2111.03 clearly defines "consisting essentially of." The Applicant further submits, the inclusion of "consisting essentially of" does not constitute new matter, as the Applicant's specification makes clear the how the inclusion of the elements in Ayd would constitute a material change. For example, and as described in more detail below, Ayd discloses an internal power supply in the server (or chassis as described in Ayd). The inclusion of this internal power supply constitutes a

App. No. 10/081,801
Attorney Docket No. 3501.2.1 NP

material change as one of the main functions of the Applicant's original specification is to reduce the amount of power and include a single power supply, as described previously. Accordingly, the Applicant submits the limitation of Claim 30 of "consisting essentially of" is proper.

Response to 102 rejections

In response to the 35 U.S.C. 112 rejections the Applicant has canceled claims 1-29 and added claims 30-50. To be anticipated by 35 U.S.C. 102, a reference must include every element and/or limitation disclosed in the claims. See MPEP 2131. Independent Claims 30, 32, and 41 now include the limitation of the server "not including an internal power supply disposed therein." Nowhere in Ayd is there teaching suggestion or motivation of the server (or chassis as labeled in Ayd) not having an internal power supply. Indeed, Ayd, as argued in the previous response teaches the exact opposite (See Ayd figures 1, col. 3 lines 1-3). Further, Ayd specifically states the server (or removable chassis) includes a power supply. (col. 3 lines 1-3) Accordingly, the Applicant submits Independent claims 30, 32, and 41 are not anticipated by Ayd.

Additionally, the Applicant's Claim 30 includes the limitation of "consisting essentially of" which as defined by the MPEP and by the previous response, means the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. See MPEP 2111.03. Ayd includes a multitude of materials, steps that materially effect the claimed invention. First, the internal power supply, as previously discussed. Second, Ayd includes a cooling fan internally contained within the server (chassis). The cooling fan and internal power

App. No. 10/081,801
Attorney Docket No. 3501.2.1 NP

supply as disclosed in Ayd causes the server or chassis to run hotter, require more power to be drawn for use, require a more bulky server system, etc. Accordingly, Applicant submits the limitation of "consisting essentially" overcomes any anticipation by Ayd.

In addition to not including an internal power supply, the power configuration in the Applicant's invention is setup completely different to that of Ayd. The Applicant's invention teaches power entering the system externally and flowing in one direction from the CPU subsystem and then to the disk drive. In contrast in Ayd, the raw power flows through the CPU to the internal power supply in the disk subsystem, and then power flows from that internal power supply back to the CPU to power its circuitry. No such structure exists in the present application".

Further, Claims 39 and 42-43 disclose a second disk drive being coupled to the underside of the main CPU unit. Nowhere in Ayd is there any teaching, suggestion or motivation for a second disk drive being coupled to the underside of the main CPU unite (or chassis). While Ayd does teach having a pair of disk drives, these disk drives are enclosed in a single enclosure or chassis. In contrast, in the Applicant's claimed invention, the first and second disk drives are separate and can be functionally separate, thereby enabling a user to dislodge or disconnect the 2nd disk drive if not in use or not needed.

Response to 35 U.S.C. 103 Rejections

In response to the 35 U.S.C. 103 rejections the Applicant has canceled Claims 1-29, and added new Claims 30-50. The Applicant submits Claims 30-50 are not obvious in view of the Examiner's cited references as claims 30-50 are not anticipated by Ayd.

App. No. 10/081,801
Attorney Docket No. 3501.2.1 NP

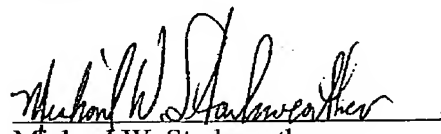
New Matter

New Claims 30 – 47 relate to subject matter found in the original claims, the original specification, and the original drawings. The Applicant believes that the new claims more particularly point out the subject matter believed to be patentable as described above. Accordingly, the Applicant believes that the new claims do not include any new matter.

Conclusion

For these reasons, it is believed that none of the prior art teaches the claimed invention. Furthermore, it is believed that the foregoing amendment has adequate support in the specification, and accordingly there should be no new matter. Applicant believes the pending claims have addressed each of the issues pointed out by the Examiner in the Office Action. In light of the foregoing amendment, the claims should be in a condition for allowance. Should the Examiner wish to discuss any of the proposed changes, Applicant again invites the Examiner to do so by telephone conference.

Respectfully Submitted,


Michael W. Starkweather
Registration No. 34,441
Attorney for Applicant

Date: 2/21/08

Michael W. Starkweather
Advantia Law Group
9035 South 1300 East
Suite 200
Sandy, Utah 84094
Telephone: 801/272-8368